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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,563	10/24/2003	Matt F. Surowiecki		2426

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EXAMINER
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CHAPMAN, JEANETTE E

ART UNIT	PAPER NUMBER
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3635

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/694,563	<b>Applicant(s)</b> SUROWIECKI, MATT F.	
	<b>Examiner</b> Chapman E. Jeanette	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/21/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6854237 in view of Osterle (6428258).

Patent '237 discloses a structural wall comprising:

- An elongated .....upper channel member having spaced apart side walls defining an upper channel space between them
- An upwardly opening lower stud having spaced side wall defining a lower channel space
- An elongated sheet metal stud

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- An upper end sized to fit within the upper channel space and including spaced apart side walls that are contiguous with the side walls of the upper channel when the upper end of the stud is within the upper channel space
- A nail/screw with a head and a threaded shank
- One side of the upper end of the stud including a longitudinal slot capable of receiving the unthreaded portion of the shank of the screw fastener; this statement of intended use has not positively claimed the structure combination but merely recites what the structure is capable of doing; the slot is probably wider than the screw
- A lower end portion that fits within and is connected to the lower channel
- The elongated slot long enough to permit vertical movement of the stud relative to the screw and the upper channel

Osterle discloses a nail/screw comprising:

- a head 5 and
- a shank connected to the head 5;
- the shank having a threaded end portion 3/4 and a shank portion 11 without threads between the threaded end 3/4 and the head 5
- the threaded portion of the shank includes an end thread space close to the upper end of the stud;
- a self tapping pointed end 2 adapted to be bore through a substrate

In view of the above, it would have been obvious to employ the screw of Osterle in the structural wall of patent ' in order to 237 to provide rapid penetration of the work piece without significant heat development as taught by Osterle. Further with the screw of Osterle in the wall construction of patent 237, the screw is now connected to the side wall of the upper channel 0 with its shank extending through the slot and the unthreaded portion of the shank in the slot; The threaded portion of the screw is a free of connection with the stud at certain location on the stud; further, Osterle discloses an end thread is wider than the slot or opening so that it will contact the structural member on the sides of the opening and prevent the screw from being pulled out of the slot.

In view of the above, it would have been obvious to one of ordinary skill in the art to provide the spacing of the studs with an upper end spaced downwardly from the top web of the upper channel and to rotate the screw to firmly connect the recited parts in order to make an adjustable frame.

Claims 2-4 and 6-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6854237 in view of Osterle (6428258) as applied to claim 1 and further in view of Laughlin (5740994). Patent '237 lacks the dimpled openings for the upper and lower channels to receive a screw fastener. Laughlin discloses the importance of anti-twist dimples 43-45 to strengthen the construction of the stud around the hole in which the screw is inserted. Laughlin also teaches the screw with the threaded and unthreaded portions; see element 49. In view of the above, it would have been obvious to include dimples to

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strengthen the construction of the stud in the area of the screw hole as taught by Laughlin

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady (5127760) in view of Osterle and Defrancesco et al (5685121).

Brady discloses a structural wall comprising:

- An elongated .....upper channel member 10having spaced apart side walls defining an upper channel space between them
- An elongated sheet metal stud 12
  - An upper end sized to fit within the upper channel space and including spaced apart side walls that are contiguous with the side walls of the upper channel when the upper end of the stud is within the upper channel space
  - A nail/screw 20 with a head and a threaded shank see figures 1-2
  - One side of the upper end of the stud including a hole 22 capable of receiving the unthreaded portion of the shank of the screw fastener;

Defrancesco discloses a structural wall by the method comprises providing:

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- An elongated .....upper channel member 42 having spaced apart side walls defining an upper channel space between them
- An upwardly opening lower stud 49 having spaced side wall defining a lower channel space
- An elongated sheet metal stud 10
  - An upper end sized to fit within the upper channel space and including spaced apart side walls that are contiguous with the side walls of the upper channel when the upper end of the stud is within the upper channel space
  - One side of the upper end of the stud including a longitudinal slot 34 capable of receiving the unthreaded portion of the shank of the screw fastener; see column 2, lines 54-58
  - A lower end portion that fits within and is connected to the lower channel
  - The elongated slot 34 long enough to permit vertical movement of the stud relative to the screw and the upper channel

Osterle discloses a nail/screw comprising:

- a head 5 and
- a shank connected to the head 5;
- the shank having a threaded end portion 3/4 and a shank portion 11 without threads between the threaded end 3/4 and the head 5
- the threaded portion of the shank includes an end thread space close to the upper end of the stud;

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- a self tapping pointed end 2

Brady discloses the elongated slot on the header instead of the stud; the slot performs the same adjustable positioning between the two parts regardless of location. Merely recited is a rearrangement of parts; the function of the slot remains the same. In view of the above it would have been obvious to employ the optional slot on the stud and the screw of Osterle allowing longitudinal movement while allowing rapid penetration of the screw into the work piece without significant heat development as taught by Defrancesco et al and Osterle,

Further with the screw of Osterle in the wall construction of Brady, the screw may be now connected to the side wall of the upper channel with its shank extending through the slot and the unthreaded portion of the shank in the slot; The threaded portion of the screw is a free of connection with the stud at certain location on the stud; further, Osterle discloses an end thread is wider than the slot or opening so that it will contact the structural member on the sides of the opening and prevent the screw from being pulled out of the slot.

In view of the above, it would have been obvious to one of ordinary skill in the art to provide the spacing of the studs with an upper end spaced downwardly from the top web of the upper channel and to rotate the screw to firmly connect the recited parts in order to make an adjustable frame.

Claims 2-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady (5127760) in view of Osterle and Defrancesco et al (5685121) and further in view of Laughlin (5740994). Brady lacks the dimpled openings for the upper and lower



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channels to receive a screw fastener. Laughlin discloses the importance of anti-twist dimples 43-45 to strengthen the construction of the stud around the hole in which the screw is inserted. Laughlin also teaches the screw with the threaded and unthreaded portions; see element 49. In view of the above, it would have been obvious to include dimples to strengthen the construction of the stud in the area of the screw hole as taught by Laughlin.

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-Fri, 8:30-6:00, every other fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER  
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